

REMARKS

In the Office action dated July 8, 2005, claims 1-4, 13-16, 19-22 and 25-28 (all pending claims) were again rejected under 35 USC 103(a) as being unpatentable over Fee in view of Cole, US patent 5,854,901. Applicant respectfully traverses this rejection.

The Examiner was not persuaded by Applicant's arguments dated May 3, 2005 regarding the MPEP 2143 requirement that the prior art references must teach or suggest all the claim limitations, stating that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In support of this assertion, Examiner cited *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to claims 1, 13, 18, and 25 (all pending independent claims), Applicant respectfully submits that section 2143 of the MPEP still lists the requirements of an obviousness type rejection, namely (the third requirement) that the references when combined must teach or suggest all of the claimed limitations.

Applicant asserts that the Examiner has failed to appreciate the import of both of *In re Keller* and *In re Merck and Co.* and has ignored the Manual of Patent Examining Procedure at section 2143. Specifically, Examiner's attention is directed to *In Re Merck and Co.*, at 231 USPQ 380: *Non-obviousness cannot be established by attacking references individually, where the rejection is based upon the teachings of a combination*

Docket No.: CISCO-3550

of references... Thus, Petersen must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. (Emphasis added)

This settled case law is not at odds with the requirements set forth in MPEP 2143, or this section of the MPEP would have been removed certainly within the 19-24 years *since In re Keller* and *In re Merck* were decided. Applicant submits that the Examiner has failed to show how Cole's disclosure of "a discovery process determining whether proposed IP addresses are available for use by the router" is somehow transformed to teach or suggest the claimed limitation of verifying that a system switch processor ("SSP") has been assigned an IP address simply by being read in light of Fee.

Specifically, the discovery process of Cole determines whether proposed IP addresses are available for use by a router. This is not the same as determining that a system switch processor has been assigned an IP address. As explained in the very portion of Cole cited by the Examiner, the IP addresses Cole considers to be "proposed IP addresses" are not assigned to the router, but are part of the source address.

The Examiner cites Cole at column 4, lines 33-38 as teaching assigning an IP address to a router with a verification that no other device in the network segment has the IP address that is assigned to the router. Applicant refutes this characterization teaches the claimed limitation of verifying that an SSP has been assigned an IP address. Cole, at Column 4, lines 33-38, reads:

Docket No.: CISCO-3550

Any device on network segment 20 (FIG. 1) that has an IP address matching the proposed IP address, responds to the ARPO request in transaction 54. If there is no reply to the ARP request after being transmitted several times, the proposed IP address associated with the ARP request is assigned to the router.

Applicant's claim must be considered for its claimed limitations. In re Ryoka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Specifically, as claimed, it is from the SSP to which the IP address is assigned that a discovery protocol package is obtained. Cole and Fee actually teach away from this limitation, as the Cole teaches assigning an IP address to a router if no other devices having that IP address respond to an ARP.

If the Examiner wishes to support this rejection based on inherency, an Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one). Applicants submit that the Examiner has not made a prima facie case of anticipation of the present claims based on inherency because there is no showing that the portions of the cited prior art show the limitation of verifying that a system switch processor has been assigned an IP address.


Docket No.: CISCO-3550

If the Examiner has any questions regarding this application or this response, the Examiner is requested to telephone the undersigned at 775-586-9500.

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Sierra Patent Group, Ltd.
P.O. Box 6149
Stateline, Nevada 89449
Telephone: (775) 586-9500

Respectfully submitted,
SIERRA PATENT GROUP,
LTD.


John W. Crosby
Reg. No. 49,058